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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,474	05/26/2000	Charles Philippe Tresser	YO999-486	9995

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EXAMINER

HUSEMAN, MARIANNE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,474

Applicant(s)

TRESSER, CHARLES PHILIPPE

Examiner

M. Huseman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/26/00 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the U.S. Patent Application serial number "09/569,068" must be inserted on page 1, last line. Appropriate correction is required.
2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (<http://www.ini.cmu.edu/netbill>, see page 8 of the specification). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.
3. The disclosure is further objected to because of the following informalities:

On page 7, lines 12 – 13, it is not clear as to whether a new "n" of S(C,n) is chosen for each I, or a new "n" is chosen for each transaction (regardless of I).

Also, it is not clear as to what applicants mean by "verifier"; i.e., what are "medical practices for health insurance" and "garages"? Do Applicants mean medical practitioners or facilities and, for garage, do Applicants mean auto repair shops? What do they verify?

On page 8, lines 6 – 9, it is not clear as to what is meant by "...which allows to encrypt...".

On page 8, line 10, it is not clear as to what "pu2(I,C)" or "pu1(I)" represent; how are they to be read; e.g., pu2(I,C) is the second party's public key and (I,C) is to be read, how? What is the significance of the "1" and "2"?

Appropriate correction is required.

Drawings

4. The drawings are objected to because the dark background, used for some of the boxes, makes the writing within those boxes illegible. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 24 – 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear as to where in the specification there is disclosure for the code claimed in claim 24.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 – 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear as to what is meant grammatically by “providing a third party...between the first and second parties”.

In claim 6, there is no proper antecedent basis or “each new business unit and other partner”.

In claim 6, line 4, “transaction” should be plural.

In claim 7, line 4, there is no proper antecedent basis for “third party I” (emphasis added).

In claim 8, line 1, there is no proper antecedent basis for “when deciding to register” as there is no mention of registering in claim 2.

In claim 8, line 2, it is not understood as to what is meant by “an application and a software to encrypt” (emphasis added).

In claim 8, line 3, there is no proper antecedent basis for “(Pr1(I),pu1(I))”.

In claim 8, line 2, the specification states that the software is downloaded by the customer from the entity's web page (the software allows the customer to encrypt), yet the claim states that the customer is sending the software to the third party. Which situation is the case?

In claim 24, there is no proper antecedent basis for (Pr1(I),pu1(I)).

In claim 24, is the customer sending the “code”?

In claim 34, line 5, "parties" should be singular. This is also true for claim 35, lines 7 and 9.

Overall, most of Applicant's claims are indefinite, failing to conform to current U.S. practice. They are replete with grammatical and idiomatic errors. Applicants are respectfully requested to review and correct all applicable claims.

While some of the claims have been considered on their merits, others could not as it is not clear to the Examiner exactly what is being claimed.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1 – 3, 8, 11, 12, 15, 19, 20, 23 and 34 – 37 are, rejected under 35 U.S.C. 102(e) as being anticipated by Linehan.

Regarding claims 1, 34 and 35:

Linehan, figure 2C, discloses a payment protocol such that Applicant's first party reads on element 202, Applicant's second party reads on Element 204, Applicant's third party reads on element 214 and Applicant's step of conducting such that the identity of the first party is kept from the second party reads on the lack of the first party's identification being forwarded to the merchant (second party) and the disclosure that consumer (first party) certificates are not required, column 11, lines 49-54.

Regarding claims 2, 36 and 37:

Applicant's proprietary item reads on column 7, lines 21 – 54.

Regarding claim 3:

Applicant's step of establishing a relationship reads on columns 3 and 4, lines 66 – 67 and lines 1 – 2, respectively.

Regarding claim 8:

Applicant's step of registering and attaining software reads on the consumer' wallet and the wallet program, column 5, lines 50 – 65 and column 7, lines 21 – 37.

Regarding claims 11 and 12:

Applicant's verifier reads on the issuer gateway and columns 7 and 8, lines 63 – 67 and lines 1 – 12, respectively.

Regarding claim 15:

Applicant's relationship such that the business entity interacts with the customer despite not knowing an identity of customer reads on the merchant dealing with the customer without knowing the customer's actual credit card number.

Regarding claim 19:

Applicant's purveyor reads on the merchant.

Regarding claim 20:

Applicant's portable device reads on the smart card and the authorization reads on the log on required when initiating the wallet.

Regarding claim 23:

The issuer gateway of Linehan receives the user's identification (customer) and the merchant (business entity) receives a reference or alias account number/

11. Claims 1 – 3 and 34 – 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Low et al.

Regarding claims 1, 34 and 35:

Low et al, figure 2, discloses anonymous credit card transactions such that Applicant's first party reads on element 231, Applicant's second party reads on element 245, and Applicant's third party reads on elements 213 and 227.

Regarding claims 2, 36 and 37:

Applicant's proprietary item reads on the anonymous credit card.

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Regarding claim 3:

Applicant's step of establishing a relationship reads on the customer establishing an account with Bp.

12. Claims 1 – 3, 15, 19, 23, 35, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabber et al.

Gabber et al disclose a system and method for providing anonymous personalized browsing by a proxy system in a network such that Applicant's first party reads on element 105a, Applicant's second party reads on element 110g and Applicant's third party reads on element 110a.

Regarding claims 2, 36 and 37:

Applicant's proprietary item reads on the alias name, id and password supplied by the proxy server.

Regarding claim 3:

Applicant's relationship reads on the operation of the proxy server.

Regarding claims 15 and 23:

Applicant's business entity interaction with the customer reads on the discussion of figure 4.

Regarding claim 19:

Applicant's step of selecting a merchant (purveyor) reads on the user browsing the web and deciding to purchase from a merchant.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan in view of Holloway.

While Linehan does not specify that the smart card (portable device) carries biometrics, Holloway discloses a smart card which can carry finger print, facial image, retinal pattern etc., column 5, lines 41 – 44. Therefore, it is considered that it would

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have been obvious to one of ordinary skill in the art at the time of the invention to store biometric patterns on the card itself as taught by Holloway for the smart card of Linehan as this is considered a more secure method (as opposed to user id and password, alone) of identifying/authenticating the user of a smart card.

Conclusion

15. Applicant, please note that in view of the 35 USC § 112 rejections given above, the allowability of the claims not rejected with art cannot be determined.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fujisaki et al teaches an anonymous electronic cash implementing method using a trustee.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

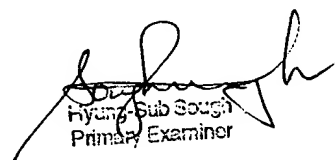
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



M. Huseman
Examiner
Art Unit 3621

mh
August 6, 2002



Hyung-Sub Souh
Primary Examiner